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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,357	11/20/2001	Peter Everett Brooks	6954.01	3338

25763 7590 09/21/2004

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EXAMINER

NICOLAS, FREDERICK C

ART UNIT PAPER NUMBER

3754

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,357	Applicant(s) BROOKS, PETER EVERETT	
	Examiner Frederick C. Nicolas	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-17, 19, 20, 23, 25-34, 36, 37, 39, 40 and 42-58 is/are pending in the application.
- 4a) Of the above claim(s) 10, 18 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-15, 19, 20, 25-34, 37, 39, 40, 42-49, 51-53, 55, 57 and 58 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 16, 17, 23, 36, 45, 46, 50, 54 and 56 is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-9,11-17,19,20,23,25-34,36,37,39,40 and 42-58.

DETAILED ACTION

Claim Objections

1. Claim 37 is objected to because of the following informalities: claim 37, line 6, "the drive element" should be --a drive element--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 11-15, 19-20, 25-34, 37, 39, 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Mutschler 3,334,354.

Mutschler discloses a liquid dispensation device (col. 1, ll. 52-56), which comprises a pin element (12) moveably oriented to move between a retracted position and extended position, wherein a portion of the pin element is in contact with a substrate as seen in Figure 3, a drive element (56,57) operatively coupled with the pin element, wherein the drive element is operating the pin element (col. 7, ll. 62-66), wherein the drive element is not mechanically coupled with the pin element as seen in Figure 7, the drive element is magnetically coupled with the pin element (col. 7, ll. 62-66), an encasement/nozzle defining a chamber (10) and an orifice (22) communicating with the chamber, wherein the pin element is slideably received within the chamber, the pin element moving between the retracted position and the extended position, the

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extended position describing a portion of the pin element extending out of the chamber through the orifice as seen in Figures 1-3, a drive element (53) in contact with the pin element, the driven element being magnetically coupled with the drive element, wherein the drive element is oriented to magnetically move the driven element (col. 7, ll. 62-66), the transfer pin motion is hydraulically restrained by the liquid in the chamber as seen in Figures 1-2, and it is inherent that the transfer pin motion of Mutschler is hydraulically restrained by the liquid in the chamber in as much as the applicant's claimed invention, the transfer pin inhibits any inadvertent escape of the liquid from the dispensation orifice as seen in Figures 1-3.

4. Claims 37,40,42,44,47-49,51-53,55,57-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Blette et al. 5,186,982.

Blette et al. disclose a method of dispensing a liquid (col. 2, ll. 3-5), which comprises the steps directing a quantity of liquid into a chamber (40,16) defined by a nozzle (12), the chamber being in fluid communication with a dispensation orifice (46), moving a transfer pin (22) from a retracted position within the chamber to an extended position, wherein the transfer pin is not mechanically coupled to a drive element (col. 2, ll. 65-68 onto col. 3, ll. 1-32), whereby the transfer pin contacts a substrate and carries an amount of liquid from the chamber to the substrate as seen in Figures 1 and 3, the transfer pin motion is hydraulically restrained by the liquid in the chamber as seen in Figures 1-2, and it is inherent that the transfer pin motion of Blette et al. is hydraulically restrained by the liquid in the chamber in as much as the applicant's claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mutschler 3,334,354 in view of Miller et al. 5,758,650.

Mutschler has all the features of the claimed invention except for the magnet is a rare earth magnet. Miller et al. teaches the use of a rare earth magnet 400, where the rare earth magnet is Smco (column 6, lines 30-39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Mutschler's magnet with the magnet of Miller et al. in order to provide a different type of magnets that are magnetically much stronger for a given size than ferrous magnets and they have a higher resistance to demagnetization.

Allowable Subject Matter

7. Claims 8-9,16-17,23,36,45-46,50,54,56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

8. Applicant's arguments filed 6/01/2004 have been fully considered but are moot in view of the new ground(s) of rejection.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (703)-305-6385. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mancene L. Gene, can be reached on 703-308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FN
September 20, 2004

 9/20/04
Frederick C. Nicolas
Patent Examiner
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